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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/511,099	06/09/2005	Masanori Sera	260087US0PCT	6203

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EXAMINER	
NUTTER, NATHAN M	

ART UNIT	PAPER NUMBER
1796	

NOTIFICATION DATE	DELIVERY MODE
03/24/2008	ELECTRONIC

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

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Office Action Summary	Application No.	Applicant(s)	
	10/511,099	SERA ET AL.	
	Examiner	Art Unit	
	Nathan M. Nutter	1796	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE *3* MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *26 February 2008*.

2a)☒ This action is **FINAL**. 2b)☐ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *1-8* is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *1-8* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☐ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☐ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☐ Information Disclosure Statement(s) (PTO/SB/08) Paper No(s)/Mail Date _____.
4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____.
5) ☐ Notice of Informal Patent Application
6) ☐ Other: _____.

DETAILED ACTION

Response to Amendment

In response to the amendment filed 26 February 2008, the following is placed in effect.

The rejection of claims 1, 4 and 6-8 under 35 U.S.C. 102(b) as being anticipated by Shimizu et al (US 5,049,613), is hereby expressly withdrawn.

The rejection of claims 1, 2 and 4-7 under 35 U.S.C. 102(b) as being anticipated by Abe et al (US 5,218,048), is hereby expressly withdrawn.

The rejection of claims 1 and 5-8 under 35 U.S.C. 102(b) as being anticipated by Hauenstein et al (US 6,013,217), is hereby expressly withdrawn.

The following grounds of rejection are being maintained and are herein repeated.

Double Patenting

The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. A nonstatutory obviousness-type double patenting rejection is appropriate where the conflicting claims are not identical, but at least one examined application claim is not patentably distinct from the reference claim(s) because the examined application claim is either anticipated by, or would have been obvious over, the reference claim(s). See, e.g., *In re Berg*, 140 F.3d 1428, 46 USPQ2d 1226 (Fed. Cir. 1998); *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) or 1.321(d) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent either is shown to be commonly owned with this application, or claims an invention made as a result of activities undertaken within the scope of a joint research agreement.

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

Claims 1-8 are provisionally rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 1-9 of copending Application No. 10/577,496 (US 2007/0079825) Sera et al. Although the conflicting claims are not identical, they are not patentably distinct from each other because the copending application claims a composition that may comprise a higher alpha olefin copolymer, a thermoplastic resin and an elastomeric resin blend produced into an article, as recited and claimed herein.

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

Claim Rejections - 35 USC § 102/103

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

> A person shall be entitled to a patent unless –
>
> (b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

Claims 1-8 are rejected under 35 U.S.C. 102(b) as anticipated by or, in the alternative, under 35 U.S.C. 103(a) as obvious over Abe et al (US 5,218,048).

The reference to Abe et al shows the contemplated blend of "a higher α-olefin" polymer which may contain "50 mol% or more" of the monomer. The reference shows the higher alpha olefin homopolymers at column 3 (lines 20-35). The paragraph bridging column 3 to column 4 teaches the use of the thermoplastic resin and column 10 (line 45) to column 11 (line 27) teaches the employment of the elastomer. Further, note column 3 (lines 56-62) for the molecular weight which would be expected to be within the range of claim 4. As regards the MWD of "4.0 or less" there is no indication that the value would or could be higher than one.

The reference shows the resin blend, as pointed out above. The employment of a stereoregular homopolymer of 1-decene would be within the purview of the reference, absent reasoning as to why it would not be. The molecular weight range and molecular weight distribution would also be expected to be within the ranges recited. A skilled artisan would have a high level of expectation of success following the teachings of the reference to arrive at the instantly claimed invention.

As such, the instant claims are deemed to be at least obvious, if not anticipated, by the teachings of the reference.

Claims 1 and 3-8 are rejected under 35 U.S.C. 102(b) as anticipated by or, in the alternative, under 35 U.S.C. 103(a) as obvious over Iwata et al (US 5,430,080).

The reference to Iwata et al teaches the manufacture of a blend composition of a thermoplastic resin that, at the paragraph bridging column 6 to column 7 may includea homopolymer of 1-decene with another thermoplastic resin. Though the reference is not specific as to stereoregularity of the poly(1-decene), such would be within the purview of the reference, absent reasoning as to why it would not be. The molecular weight range and molecular weight distribution would also be expected to be within the ranges recited. Since the higher olefin polymer is identical to that recited herein, the melting point would be expected to embrace that of claim 5. The particular catalyst employed in the manufacture of the resin fails to provide any patentable weight to the claims since the claims are drawn to a composition. Process claims in a product-by-process situation have been held not to be claim limitations. See *SmithKline Beecham Corp. v. Apotex Corp.*, No. 04-1522 (Fed. Cir. February 24, 2006).

As such, the instant claims are deemed to be at least obvious, if not anticipated, by the teachings of the reference.

Response to Arguments

Applicant's arguments filed 26 February 2008 have been fully considered but they are not persuasive.

With regard to the provisional rejection of claims 1-8 on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 1-9 of copending Application No. 10/577,496 (US 2007/0079825) Sera et al, no Terminal Disclaimer has been filed.

With regard to the rejection of claims 1-8 under 35 U.S.C. 102(b) as anticipated by or, in the alternative, under 35 U.S.C. 103(a) as obvious over Abe et al (US 5,218,048), applicants ignore the teachings pointed out by the Examiner as to the monomers. Further, it is submitted that the monomers disclosed at column 3 (lines 19 et seq.) include many as disclosed in the instant Specification at page 14 (lines 6-13) of 10 to 40 carbon atoms, and a polymer, especially a homopolymer produced therefrom would, indeed, have the melting point range recited herein. Nothing on the record would indicate otherwise. As such, the claims are at least obvious, if not anticipated, by the teachings of the patent.

With regard to the rejection of claims 1 and 3-8 under 35 U.S.C. 102(b) as anticipated by or, in the alternative, under 35 U.S.C. 103(a) as obvious over Iwata et al (US 5,430,080), again, applicants ignore the teachings pointed out by the Examiner as to the monomers. Further, it is submitted that the poly(1-decene) resin disclosed at column 7 (line 2) would, indeed, have the melting point range recited herein. Nothing on the record would indicate otherwise. As such, the claims are at least obvious, if not anticipated, by the teachings of the patent.

THIS ACTION IS MADE FINAL. Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within

TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Nathan M. Nutter whose telephone number is 571-272-1076. The examiner can normally be reached on 9:30 a.m.-6:00 p.m..

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, James J. Seidleck can be reached on 571-272-1078. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Nathan M. Nutter/
Primary Examiner, Art Unit 1796

nmn

14 March 2008